



PATENT
10/601,687

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of: Thomas C. Russell

Group Art Unit: 2127

Serial No.: 10/601,687

Filed: June 23, 2003

Attorney Docket: M02A442

Examiner:

Title: METHOD AND APPARATUS FOR SELF-CONFIGURING SUPERVISORY CONTROL AND DATA ACQUISITION (SCADA) SYSTEM FOR DISTRIBUTED CONTROL

Mail Stop: MISSING PARTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition Under 37 CFR 1.47(b) and in Response to Notice of Missing Parts of Nonprovisional Application

Dear Sirs:

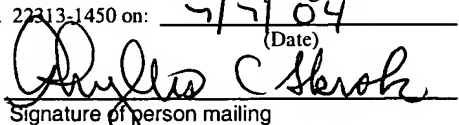
The present application was filed on June 23, 2003 naming two inventors; Thomas C. Russell (Russell) and Charles M. Winterfeldt (Winterfeldt), such application being filed without a Declaration or Assignment.

A Notice of Missing parts of Nonprovisional Application (Notice) was mailed December 31, 2003, requiring the filing of a proper oath or declaration along with necessary fees.

In response to such Notice, the Declaration of inventor Russell is being submitted herewith. An Assignment of the invention from inventor Russell to The BOC Group, Inc. is also being submitted herewith.

However, after repeated requests, inventor Winterfeldt has refused to sign either the Declaration or the Assignment.

Therefore, a petition under 37 CFR 1.47(b) is also being made at this time. This petition is based on the following facts.

| <u>CERTIFICATE OF MAILING</u> | |
|---|--|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on: <u>7/7/04</u> (Date) | |
| <u>PHYLLIS C. SKROK</u> Printed name of person signing this certificate | <u></u> Signature of person mailing |

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- 1) At the time of invention of the subject matter of the present application, inventor Winterfeldt was an employee of The BOC Group, Inc., and had executed an Employment Agreement with The BOC Group, Inc. stating in part that:
I shall promptly grant and assign to the Company for its sole use and benefit any and all inventions and improvements together with all letters patent and reissues thereof that may at any time be granted for or upon any such inventions or improvement which I may make or conceive during the period of my employment.
(A copy of the Employment Agreement is attached.)
- 2) Inventor Winterfeldt subsequently left the employment of The BOC Group, Inc. and at the time of receipt of the Notice, was no longer employed by The BOC Group, Inc.
- 3) Repeated attempts to have inventor Winterfeldt sign the Declaration and Assignment have gone unanswered. In particular, copies of the Declaration and Assignment were sent to inventor Winterfeldt of three different occasions; July 31, 2003, January 30, 2004 and May 19, 2004, all of which went unanswered.
(A copy of each of the cover letters sent is attached.)
- 4) Several attempts to reach inventor Winterfeldt by phone have gone equally unanswered. This included a phone call to inventor Winterfeldt by a human resources representative of The BOC Group, Inc., to which inventor Winterfeldt stated he was not interested in signing any paperwork.
(A copy of a email message reporting the above is attached.)

This action is necessary to preserve the rights of The BOC Group, Inc. in the invention set forth in the present application and to prevent irreparable damage to The BOC Group, Inc. In other words, absent the granting of this petition, the present application will become abandoned for failure to respond to the Notice, thereby resulting in a loss of rights in the invention being claimed.

The last know address for inventor Winterfeldt is that on the letters noted above. In particular, such address is:

Mr. Charles Winterfeldt
10195 Bell Avenue
Plato, MN 55370

In light of the above showing and the payment of the fee prescribed for this petition under 37 CFR 1.17(h), grating of this petition is respectfully requested.

Further, in light of the above and the submission of the Declaration and Assignment of inventor Russell and the payment of the appropriate fees for responding to the Notice, it is respectfully requested that all submissions herewith be accepted and that the present application be further processed and examined.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'DAVID A. HEY', written over a horizontal line.

David A. Hey
Attorney of Record
Registration No. 32,351

Date: July 7, 2004

The BOC Group, Inc.
575 Mountain Avenue
Murray Hill, NJ 07974
(908) 771-6385



M02A442

| SENDER: COMPLETE THIS SECTION | | COMPLETE THIS SECTION ON DELIVERY | |
|---|--|---|--|
| <p>■ Complete items 1, 2, and 3. Also complete item 4 if Restricted Delivery is desired. Print your name and address on the reverse so that we can return the card to you. Attach this card to the back of the mailpiece, or on the front if space permits.</p> | | <p>A. Received by (Please Print Clearly) <u>Charles Winterfeldt</u> B. Date of Delivery <u>5-28-04</u></p> | |
| <p>1. Article Addressed to:</p> <p>Mr. Charles M. Winterfeldt 10195 Bell Ave. Plato, MN 55370</p> | | <p>C. Signature <u>x Charles M. Winterfeldt</u> <input type="checkbox"/> Agent</p> <p>D. Is delivery address different from item 1? <input type="checkbox"/> Yes <input checked="" type="checkbox"/> No If YES, enter delivery address below:</p> | |
| <p>2. Article Number (Copy from service label)</p> <p>7000 1670 0012 2713 0388</p> | | <p>3. Service Type</p> <p><input checked="" type="checkbox"/> Certified Mail <input type="checkbox"/> Express Mail</p> <p><input type="checkbox"/> Registered <input checked="" type="checkbox"/> Return Receipt for Merchandise</p> <p><input type="checkbox"/> Insured Mail <input type="checkbox"/> C.O.D.</p> | |
| <p>PS Form 3811, July 1999</p> | | <p>4. Restricted Delivery? (Extra Fee) <input type="checkbox"/> Yes</p> | |

Domestic Return Receipt

102595-00-M-0952



 **THE BOC GROUP**

CERTIFIED MAIL
RETURN RECEIPT REQUESTED

575 Mountain Avenue, Murray Hill, New Jersey 07974-2082

Tel: (908) 464-8100

May 19, 2004

Mr. Charles M. Winterfeldt
10195 Bell Avenue
Plato, MN 55370

RE: U.S. Patent Application No. 10/601,687
Filed: June 23, 2003
Entitled: Method And Apparatus For Self-Configuring Supervisory Control And
Data Acquisition (SCADA) System For Distributed Control
Atty. Dkt.: M02A442

Dear Mr. Winterfeldt:

Further to my July 31, 2003 and January 30, 2004 letters, I enclose for your convenience a declaration and revised assignment and revised power of attorney forms for the above-referenced application. Please return to us the executed declaration, assignment and power of attorney forms to avoid any further delay or abandonment of the subject application. As you are a named co-inventor of the subject application, it is imperative that these documents be signed and returned to us as soon as possible. A prepaid pre-addressed Express Mail envelope is enclosed for your convenience.

Please note that no response from you will constitute a refusal to sign the declaration, assignment and power of attorney forms. If there is a reason why you do not wish to sign the documents, please notify me as soon as possible.

If you have any concerns or if I can provide any further information, please contact me (908-771-6469) at your earliest convenience.

Very truly yours,



Ira Lee Zebrak, Esq.
Senior Counsel - Intellectual Property
Legal Services

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Enclosures

